

## REMARKS

The Office Action mailed April 10, 2008, has been received and reviewed. Claims 1 and 3-14 are currently pending in the application. Claims 1 and 3-14 stand rejected. Applicant has amended claims 1 and 12-14, and respectfully requests reconsideration of the application as amended herein.

### 35 U.S.C. § 102 Anticipation Rejections

#### Anticipation Rejection Based on U.S. Patent No. 5,713,074 to Hulbert

Claims 1, 4-6, 8-9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,713,074 to Hulbert (“Hulbert”). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Hulbert does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of amended independent claim 1 and claims 4-6, 8, 9 and 11 depending therefrom, and amended independent claim 14, because Hulbert does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

Applicant’s invention as claimed generally recites:

(1) repeating a step until a sum determined at the mobile station of energy reaches a certain level.

Regarding a sum determined at the mobile station of energy, Applicant’s invention as presently claimed in amended independent claims 1 and 14, recite in part, “*repeating [retransmitting] until a sum determined at the mobile station of* the first and further symbol energy amounts ... is great enough to ....” Hulbert discloses no such thing.

Hulbert discloses that the “mobile station” (e.g., receiving station 22 of Hulbert’s Fig. 2) merely includes sufficient intelligence for repeating (i.e., transmitting back) a received data stream. Furthermore, the Office Action cites Hulbert’s transmitter 20 as allegedly teaching Applicant’s base station claim element. (Office Action, p. 5). Furthermore, the only summing or accumulating capability as disclosed by Hulbert occurs in Hulbert’s “base station” 20 and not in Hulbert’s “mobile station” 22. In support, Applicant respectfully cites to the Response to Arguments section of the Office Action where the Examiner concedes:

Hulbert teaches further at col. 4, lines 6-10 (see figure 2): “If the bit[s] are different, indicating an error, then the output will be high (1), and the accumulator input will be feed with +Up Step.” The *output of the accumulator [36 of “base station” 20 in Hulbert’s Fig. 2] (a sum of the first and further symbols energy amount means)* controls the power of the transmitter 38 [of “base station” 20 in Hulbert’s Fig. 2] in a logarithmic fashion.” (Office Action, pp. 2-3; emphasis added).

Clearly, Hulbert teaches that any “summing” or accumulating only occurs in Hulbert’s “base station” 20 and is not “a sum determined at the mobile station” as claimed by Applicant.

Therefore, since Hulbert does not disclose:

“*repeating [retransmitting] until a sum determined at the mobile station of the first and further symbol energy amounts ... is great enough to ...*”,

in as complete detail as claimed by Applicant, Hulbert cannot anticipate under 35 U.S.C. §102 Applicant’s invention as claimed in amended independent claim 1, from which claims 4-6, 8, 9 and 11 depend and amended independent claim 14. Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

### 35 U.S.C. § 103 Obviousness Rejections

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hulbert in view of U.S. Patent No. 6,154,659 to Jalali et al. (“Jalali”). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of amended independent claim 1 precludes a rejection of claim 3 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see*

also MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claim 3 which depends therefrom.

**Claims 7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulbert in view of U.S. Patent No. 6,581,176 to Seo (“Seo”).

The nonobviousness of amended independent claim 1 precludes a rejection of claims 7 and 10 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to amended independent claim 1 and claims 7 and 10 which depend therefrom.

**Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulbert in view of U.S. Patent No. 6,625,132 to Boettger *et al.* (“Boettger”).

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of amended independent claims 12 and 13 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or

suggest all the claims limitations. Regarding amended independent claims 12 and 13, Applicant has amended independent claims 12 and 13 to include claim limitations not taught or suggested in the cited references.

The Office Action cites Boettger for teaching a buffer. The Office Action cites Hulbert for teaching Applicant's claim elements as described above. Applicant sustains the above-proffered arguments regarding the deficient teachings or suggestions in Hulbert. Accordingly, Applicant submits that Hulbert in view of Boettger does not and cannot render obvious under 35 U.S.C. § 103 the presently claimed invention of amended independent claims 12 and 13, because the cited references, either individually or in any proper combination, do not teach or suggest all of the claims limitations.

As stated above, Applicant's invention as claimed generally recites:

(1) repeating a step until a **sum determined at the mobile station** of energy reaches a certain level.

Regarding a **sum determined at the mobile station of energy**, Applicant's invention as presently claimed in amended independent claims 12 and 13, recite in part, "transmits ... and retransmits ... **until a sum determined at the mobile station of** the first and further symbol ***energy amounts ... is great enough to ....***" Neither Hulbert nor Boettger teach or suggest any such thing. In fact, Hulbert conflictively teaches or suggests summing or accumulating occurring in the base station and not the mobile station as claimed by Applicant.

Specifically, Hulbert teaches that the "mobile station" (e.g., receiving station 22 of Hulbert's Fig. 2) merely includes sufficient intelligence for repeating (i.e., transmitting back) a received data stream. Furthermore, the Office Action cites Hulbert's transmitter 20 as teaching Applicant's base station claim element. (Office Action, p. 11). Furthermore, the only summing or accumulating capability as taught by Hulbert occurs in Hulbert's "base station" 20 and not in Hulbert's "mobile station" 22. In support, Applicant respectfully cites to the Response to Arguments section of the Office Action where the Examiner concedes:

Hulbert teaches further at col. 4, lines 6-10 (see figure 2): "If the bit[s] are different, indicating an error, then the output will be high (1), and the accumulator input will be feed with +Up Step." The ***output of the accumulator [36 of "base station" 20 in Hulbert's Fig. 2] (a sum of the first and further symbols energy amount means)***

controls the power of the transmitter 38 [of “base station” 20 in Hulbert’s Fig. 2] in a logarithmic fashion.” (Office Action, pp. 2-3; emphasis added).

Clearly, Hulbert teaches that any “summing” or accumulating only occurs in Hulbert’s “base station” 20 and is not “a sum determined at the mobile station” as claimed by Applicant.

Therefore, since neither Hulbert nor Boettger, either individually or in any proper combination, teach or suggest Applicant’s invention as presently claimed, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in amended independent claims 12 and 13.

Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

## CONCLUSION

Claims 1 and 3-14 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Respectfully submitted,

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